

REMARKS

Applicants are filing a Request for Continued Examination in reply to the Final Office Action mailed August 11, 2006. Applicants ask that all claims be allowed in view of the amendment to the claims and the following remarks.

Claims 36-42, 44-50, 52-62, and 64-66, and 68-87 are pending, with claims 36, 48, 56, 64, 68, 69, 82, and 85 being independent. Claims 43, 51, 63, and 67 have been cancelled, claims 36, 38, 44, 48, 50, 52, 56-58, 60, 61, 64-66, 68, 69, and 72 have been amended, and claims 78-87 have been added by this amendment. No new matter has been introduced. Support for the amendments and new claims can be found in the application at, for example, page 15, line 5 to page 24, line 29.

Interview Request

Applicants respectfully request the courtesy of a personal interview with the Examiner prior to substantive examination of this amendment.

Claim Rejections Under 35 U.S.C. § 103

Claims 36-38, 48-50, 56-58, 64-66, 68 and 69

Claims 36-38, 48-50, 56-58, 64-66, 68 and 69 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,212,548 (DeSimone) in view of U.S. Patent No. 6,748,421 (Ozkan).

In order to establish a prima facie case of obviousness, there must be some suggestion or motivation to modify or combine reference teachings. See, e.g., MPEP § 2143. Applicants submit that the final Office Action fails to establish a prima facie case of obviousness at least because there is no suggestion or motivation to modify the teachings of DeSimone in view of the teachings of Ozkan in the manner proposed by the final Office Action. Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 36-38, 48-50, 56-58, 64-66, 68, and 69.

With respect to independent claims 36, 56, and 68, the final Office Action acknowledges that DeSimone fails to describe or suggest an indication that triggers sending of a video instant message after generation of the video instant message is complete. See final Office Action of August 11, 2006 at page 3, lines 15-17. Therefore, the final Office action relies on Ozkan for this deficiency. See final Office Action of August 11, 2006 at page 3, line 18 to page 4, line 5. In particular, the final Office Action asserts that Ozkan teaches sending videos when a video capture process has stopped and that it would have been obvious to a person having ordinary skill in the art to modify the teachings of DeSimone in view of the teachings of Ozkan to use a trigger to send a video after it is completed "because [doing so] allows for the completed video to be automatically sent without extra, unnecessary steps from the user." Final Office Action of August 11, 2006 at page 3, line 18 to page 4, line 5.

Applicants disagree. As discussed more fully below, at the time of the invention, a person having ordinary skill in the art would not have been motivated to modify the teachings of DeSimone to use a trigger to send a video after it is completed, because what little disclosure there is in DeSimone of video communications appears to contemplate real-time instant messaging sessions which do not involve sending completed videos. Thus, for at least the following reasons, no proper combination of DeSimone and Ozkan describes or suggests the features of independent claims 36, 56, and 68, including the recited indication that triggers sending of a video instant message after generation of the video instant message is complete.

DeSimone describes a system that enables a user to maintain multiple real-time chat sessions with a plurality of other participants using a single client application. See DeSimone at col. 2, lines 30-37. Although the participants in the various different chat sessions with the user may overlap, participants send messages in the context of particular chat sessions (i.e., conversations). See DeSimone at col. 2, lines 48-56. Therefore, DeSimone's system tracks the messages sent by the participants of the chat sessions in real-time in order to present the messages received from the participants of the chat sessions to the user in a manner that identifies the particular chat sessions to which they correspond. See DeSimone at col. 2, lines 48-56.

DeSimone briefly alludes to extending its disclosure to include video chat capabilities on two occasions. In particular, at column 1, lines 45-57, DeSimone states:

Extensions of the basic chat model of communications permit use of voice (or other audio), video and other message content.

DeSimone at col. 1, lines 45-47 (emphasis added). Similarly, at column 15, lines 58-63,

DeSimone states:

though the preceding description has proceeded in terms of text messages, those skilled in the art will apply the present inventive teachings in communicating a variety of messages, including voice (or other audio), video (or other graphic) messages and in communicating mixed-mode messages or messages with a variety of attachments.

DeSimone at col. 15, lines 58-63 (emphasis added). Because DeSimone describes a system that enables a user to maintain multiple real-time chat sessions with a plurality of other participants using a single client application, extension of DeSimone's "inventive teachings" to include video chat capabilities would result in a system that enables a user to engage in multiple real-time video conferencing sessions with a plurality of other participants at one time.

Ozkan, meanwhile, describes a system for recording and sending a video in accordance with a user-defined video structure. See Ozkan at Abstract. More particularly, Ozkan describes a system that enables a user to create a hierarchical video structure for a video before recording the video. See Ozkan at col. 12, lines 20-29. Thereafter, while recording the video, the system enables the user to label the starting and ending points of different sections of the video corresponding to the user-created video structure. See Ozkan at col. 12, lines 30-58. Upon completion of recording the video, the user can send the video to other users for viewing or the user can further edit the video. See Ozkan at col. 12, line 59 to col. 13, line 45. In the case where the video is sent to other viewers for viewing, the structured organization of the video allows the other users to identify and quickly navigate to the most salient sections of the video. Similarly, in the case where the user desires to further edit the video, the structured organization of the video enables the user to quickly navigate to the sections of the video most in need of editing.

The final Office Action's position that a person having ordinary skill in the art would have been motivated to modify the teachings of DeSimone in view of the teachings of Ozkan to use a trigger to send a video after it is completed fails because, as discussed above, the natural

extension of the “inventive teachings” of DeSimone to include video chat capabilities results in a system that enables a user to engage in multiple real-time videoconferencing sessions with a plurality of other participants at one time and such real-time video conferencing sessions do not involve the sending of completed videos. Rather, once a videoconference has been established, real-time video feeds of the other participants are available without requiring any additional user intervention. Therefore, absent any impermissible hindsight gleaned from review of the present application, at the time of the invention, there would have been no motivation to modify the teachings of DeSimone in view of the teachings of Ozkan to use a trigger to send a video after it is completed.

Moreover, Ozkan's disclosure makes it clear that the system of Ozkan is not intended for use in conjunction with a presence-based communications application such as the real-time chat system described by DeSimone. For instance, Ozkan states:

typically[video] communication is not simultaneously bi-directional, as opposed to the synchronous communication of person-to-person telephone calls or video conferencing.

Ozkan at col. 1, lines 26-29. Indeed, Ozkan acknowledges that presence-based communications such as face-to-face, telephone, and videoconference conversations are “a luxury put aside for relationship building and immediate closure” Ozkan at col. 1, lines 21-22. Rather than being intended for use in conjunction with a presence-based communications platform, like that of DeSimone, Ozkan's system clearly is intended to enable a user to generate and send a video to a recipient who then may view the video at his or her convenience.

Thus, a person having ordinary skill in the art at the time of the invention would not have turned to Ozkan's teachings, which contemplate non-real-time, non-presence-based delivery of video, when considering a modification of DeSimone's teachings, which, in contrast, contemplate real-time, presence-based delivery of video. Therefore, applicants submit that the proposed combination is improper and that neither DeSimone, Ozkan, nor any proper combination of the two describes or suggests the features of independent claims 36, 56, and 68. Accordingly, for at least these reasons, applicants request reconsideration and withdrawal of the rejection of independent claims 36, 56, and 68 as well as dependent claims 37 and 38, which

depend from independent claim 36, and dependent claims 57 and 58, which depend from independent claim 56.

With respect to independent claims 48, 64, and 69, the final Office Action acknowledges that DeSimone fails to describe or suggest receiving a video instant message after receiving an indication that generation of the video instant message is completed and therefore applies Ozkan for this deficiency, asserting that it would have been obvious to a person having ordinary skill in the art to modify the teachings of DeSimone in view of the teachings of Ozkan to use a trigger to send a video after it is completed "because [doing so] allows for the completed video to be automatically sent without extra, unnecessary steps from the user." Final Office Action of August 11, 2006 at page 6, lines 1-8. As currently amended, this feature of independent claims 48, 64, and 69 has been revised to recite receiving, on behalf of the recipient, a completed video instant message sent by the sender using the video communications session.

Notwithstanding the current amendments to independent claims 48, 64, and 69, applicants submit that there remains no motivation to modify the teachings of DeSimone in view of the teachings of Ozkan. As discussed above, the natural extension of the "inventive teachings" of DeSimone to include video chat capabilities results in a system that enables a user to engage in multiple real-time videoconferencing sessions with a plurality of other participants at one time and such real-time video conferencing sessions do not involve the sending of completed video messages. Therefore, absent any impermissible hindsight gleaned from review of the present application, at the time of the invention, there would have been no motivation to modify the teachings of DeSimone in view of the teachings of Ozkan. Accordingly, for at least this reason, applicants request reconsideration and withdrawal of the rejection of independent claims 48, 64, and 69 as well as dependent claims 49 and 50, which depend from independent claim 48, and dependent claims 65 and 66, which depend from independent claim 64.

Claims 39-42 and 59-62

Claims 39-42 and 59-62, each of which depends from one of amended independent claims 36 and 56, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over DeSimone and Ozkan in view of U.S. Patent No. 6,795,863 (Doty). Doty describes a system for providing video streaming with e-mail on the Internet. See Doty at Abstract. However, Doty

does not remedy the deficiencies discussed above with respect to the teachings of DeSimone and Ozkan. Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 39-42 and 59-62.

Claims 44-47 and 52-55

Claims 44-47 and 52-55, each of which depends from one of amended independent claims 36 and 48, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over DeSimone and Ozkan in view of U.S. Patent No. 6,529,475 (Wan). Wan describes a system for reducing real-time data traffic on a multimedia communications network. See Wan at Abstract. However, Wan does not remedy the deficiencies discussed above with respect to the teachings of DeSimone and Ozkan. Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 44-47 and 52-55.

New Claims

New dependent claims 78-81 depend directly from amended independent claim 36. Accordingly, because of their dependency, applicants submit that new dependent claims 78-81 are allowable at least for the reasons discussed above in connection with amended independent claim 36.

New independent claim 82 recites a communications method that includes establishing a presence-based communications session between a sender and a recipient, and, during the presence-based communications session, receiving, from the sender, a request to establish a video communications session between the sender and the recipient that is concurrent with the presence-based communications session. In addition, the method includes establishing a video communications session between the sender and the recipient that is concurrent with the presence-based communications session in response to receiving the request to establish a video communications session between the sender and the recipient, and, during the concurrent presence-based and video communications sessions between the sender and the recipient, generating a video instant message on behalf of the sender, receiving an instruction from the sender to send the video instant message to the recipient after generation of the video instant message is complete, and, initiating a transfer of the video instant message to the recipient using

the video communications session in response to receiving the instruction to send the video instant message to the recipient.

Applicants submit that new independent claim 82 and dependent claims 83 and 84, which depend from new independent claim 82, are allowable over the prior art of record, namely DeSimone, Ozkan, Doty, and Wan, because the prior art of record, or any proper combination thereof, fails to describe or suggest the subject matter of new independent claim 82.

New independent claim 85 recites a method that includes, among other features, initiating an instant messaging session between a sender and a recipient, and enabling display, to the sender, of an instant messaging graphical user interface associated with the initiated instant messaging session in response to initiating the instant messaging session between the sender and the recipient. The method also includes determining if the recipient is capable of participating in video instant messaging in response to initiating the text instant messaging session between the sender and the recipient, and, based on a determination that the recipient is capable of participating in video instant messaging, enabling the graphical user interface associated with the instant messaging session to reflect that the recipient is capable of participating in video instant messaging.

Applicants submit that new independent claim 85 and dependent claims 86 and 87, which depend from new independent claim 85, are allowable over the prior art of record, namely DeSimone, Ozkan, Doty, and Wan, because the prior art of record, or any proper combination thereof, fails to describe or suggest the subject matter of new independent claim 85.

Conclusion

Applicants submit that all claims are in condition for allowance.

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue, or comment does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this reply, and the

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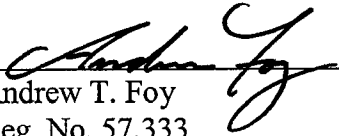
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amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

The fee in the amount of \$1,610 in payment for the Request for Continued Examination (\$790), the Petition for the One-Month Extension of Time fee (\$120), and the Excess Claim fee (\$700) is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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